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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,203	04/07/2004	Yutaka Konomura	P/2850-94	7409
2352 7590 12/28/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER LEUBECKER, JOHN P	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/820,203

Applicant(s)

KONOMURA ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Applicant's election of Group I and Species I in the reply filed on October 16, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 8-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tohjoh et al. (U.S. Pat. 4,856,495) in view of Heinrichs et al. (U.S. Pat. 6,092,722).

Tohjoh et al. disclose an endoscope insertion section (4) having a light receiving section at the tip (36,38), an optical adapter (16) detachably installed at the tip and having an optical system (19) which forms and image in the light receiving section. Tohjoh fails to disclose an

information device containing information installed in the optical adaptor and a reading section installed in the tip of the endoscope insertion section that obtains the information.

Heinrichs et al. teaches placing information devices (33, Fig.1) in components (30b,30a,18) of an endoscope system that are connected together so as to not only identify (e.g., with serial numbers), but to transmit characteristic information so that the system can automatically adapt to the characteristics of different components (e.g., col.5, lines 23-36). This is done with a reader (20, Fig.1) in a proximate component. It would have been obvious to one of ordinary skill in the art to have provided an information device in the optical adaptor of Tohjoh to identify and allow the system to adapt to that particular optical adaptor in view of the teaching of Heinrichs. Since operational proximity of the information device allows for reading of the information by an adjacent component (note col.5, lines 50-56), the reader would need to be at the distal end of the insertion section (4) of Tohjoh. One of ordinary skill in the art could have combined the elements as claimed using the methods taught by Heinrichs and such combination would have yielded the predictable result of allowing identification and adaptation of the system in accordance with the particular optical adapter being used.

As to claims 2, 4 and 5, the information device can be an IC chip (col.5, lines 57-63) and the information can be transmitted wireless through antennae (e.g., coils described in col.5, lines 37-47). As to claims 6 and 7, the coils described in col.5, lines 37-47 constitute "joining terminals" and the "connection" as claimed is met with the electromagnetic energy transmitted between them. Note that claims 6 and 7 do not explicitly require the terminals to "touch".

*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20040111012 A1 Whitman, Michael P.

US 6981941 B2 Whitman; Michael P. et al.

US 6712756 B1 Kura; Yasuhito et al.

US 6436032 B1 Eto; Tadao et al.

US 6366206 B1 Ishikawa; Akira et al.

US 5951462 A Yamanaka; Kazuhiro

US 5830121 A Enomoto; Takayuki et al.

US 5698838 A Yamaguchi; Atsuo

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/  
Primary Examiner  
Art Unit 3739

jpl